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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,902	01/28/2002	Shinichi Koyama	03500.016144	2051
5514	7590	01/14/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VIEAUX, GARY	
			ART UNIT	PAPER NUMBER

2612

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/055,902	KOYAMA, SHINICHI	
	Examiner	Art Unit	
	Gary C. Vieaux	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/14/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on the following date is in
5 compliance with the provisions of 37 CFR 1.97 and is being considered by the
Examiner: May 14, 2002.

Specification

10 The title of the invention is not descriptive. A new title is required that is clearly
indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informalities: Line 14 of
15 page 2 includes "starting" misspelled as "staring". Appropriate correction is required.

Claim Objections

Claims 1, 3 and 7 are objected to because of the following informalities:

Regarding claim 1, line 4 includes "starting" misspelled as "staring";

20 Regarding claims 3 and 7, each claim references "IEEE1394-1997 standards",
instead of "IEEE1394-1995 standards" as referenced by the specification and provided
for by IEEE. For the purposes of examination on the merits of the claims, the claims will
be interpreted to read "1995".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5 **Claims 1-8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10 The claims, as currently written, lend to multiple interpretations in relation to the recording means. The recording means can be interpreted to be indicator 103, indicator 104 or indicator 123, all using figure 1 as a reference diagram. It is unclear which means are being claimed, with each means creating contradiction in their reading. It is further unclear if the outputted AV data is "to be recorded in said recording means", or if the clause "to be recorded in said recording means" is to be read as a descriptor for the
15 AV data, merely to indicate the AV data outputted is identical to the AV data that is "to be recorded" in a storage medium. Moreover, if the recording means is interpreted to be indicator 123 of figure 1, there is no apparent support found within the specification.

20 Clarification of the claims is respectfully requested. The claims will be examined on their merits as best understood by the Examiner, with deference given to the above interpretations. Pending clarification, possible indication of allowable subject matter relating to the examination of the claims on their merits should not be inferred.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

5 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 10
10 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al.
(US #6,453,071.)

15 The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the
20 invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Ito teaches an image pickup apparatus that comprises recording means (fig. 18 indicator 19) for recording AV data including image data and sound data (col. 1 lines 17-22; fig. 18 indicator 201), and communication means (fig. 18 indicator 18) for starting an output of AV data to be recorded in said recording means
25 (col. 21 lines 22-28, in which data to be recorded is transmitted) in response to an instruction of a record start and for stopping an output of AV data to be recorded in said

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recording means in response to an instruction of a record stop (fig. 18 indicator 10; col. 15 lines 62-64, col. 21 lines 47-58, col. 22 lines 17-20.)

Regarding claim 2, Ito teaches all the limitations of claim 2 (see the 102(e) rejection to claim 1 supra) including teaching an image pickup apparatus wherein said communication means continues to output AV data to be recorded in said recording means from the instruction of the record start to the instruction of the record stop, irrespective of whether or not said recording means can normally record AV data (fig. 18, col. 21 lines 22-28; in which separate paths of the AV data are found to extend to the output, as well as to the recording medium.)

Regarding claim 3, Ito teaches all the limitations of claim 3 (see the 102(e) rejection to claim 1 supra) including teaching an image pickup apparatus wherein said communication means outputs AV data by using an isochronous transfer scheme stipulated in the IEEE1394-1995 standards (fig. 18 indicator 18; col. 7 lines 33-42.)

Regarding claim 4, Ito teaches all the limitations of claim 4 (see the 102(b) rejection to claim 1 supra) including teaching an image pickup apparatus wherein the image pickup apparatus is a camera-integrated digital video recorder (fig. 18 indicator 201; col. 15 lines 50-51.)

Regarding claims 5-8, although the wording is different, the material is considered substantively equivalent to claims 1-4, respectively, as discussed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 **Claims 1- 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US #6,184,922) in view of Greening et al. (US #5,701,912.)

Regarding claim 1, Saito teaches an image pickup apparatus that comprises recording means for recording image data (col. 4 lines 37-44) and communication means (fig. 1 indicator 6) for starting an output of AV data to be recorded in said recording means in response to an instruction of a record start and for stopping an output of AV data to be recorded in said recording means in response to an instruction of a record stop (abstract and col. 12 lines 25-32.) However, Saito does not provide for sound data to be recorded.

Nevertheless, Greening teaches the inclusion of microphones within endoscopes (col. 3 line 63 – col. 4 line 7.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include audio as taught by Greening, with the imaging apparatus as taught by Saito. One of ordinary skill in the art at the time of the invention would have been motivated to include sound data with the image data of an endoscope in order to simulate both eyes and ears inside of a body cavity.

25 Regarding claim 2, Saito and Greening teach all the limitations of claim 2 (see the 103(a) rejection to claim 1 supra) except for explicitly teaching an image pickup

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apparatus wherein said communication means continues to output AV data to be recorded in said recording means from the instruction of the record start to the instruction of the record stop, irrespective of whether or not said recording means can normally record AV data.

5 Nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention for the communication means to continue to output AV data, irrespective of whether or not the recording means can normally record AV data, so that the AV data outputted may still be observed by a viewing monitor (e.g., fig. 1 indicator 7.)

10 Regarding claim 3, Saito and Greening teach all the limitations of claim 3 (see the 103(a) rejection to claim 1 supra) including teaching an image pickup apparatus wherein said communication means outputs AV data by using an isochronous transfer scheme stipulated in the IEEE1394-1995 standards (col. 12 lines 48-50.)

15 Regarding claim 4, Saito and Greening teach all the limitations of claim 4 (see the 103(a) rejection to claim 1 supra) including teaching an image pickup apparatus wherein the image pickup apparatus is a camera-integrated digital video recorder (col. 4 lines 37-44, in which the camera, indicator 4 of fig. 1, can be integrated with a DVD-R or DVD-RAM drive.)

20 Regarding claims 5-8, although the wording is different, the material is considered substantively equivalent to claims 1- 4, respectively, as discussed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Kobayashi et al. (US #6,144,411), of the same assignee, discloses an imaging
5 apparatus in which the image to be recorded is also outputted via an IEEE-1394 bus.

Contact

Any inquiry concerning this communication or earlier communications from the
10 examiner should be directed to Gary C. Vieaux whose telephone number is 703-305-9573. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
20 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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